

REMARKS

This Application has been carefully reviewed in light of the Office Action mailed June 30, 2005. In the Office Action, Claims 1-36 are pending and the Examiner rejects Claims 1-36. Applicants amend Claims 1, 7, 10, 15, 18, 22, 26, 30, 32, 35, and 37. Applicants submit that the claim amendments do not add new matter. Applicants respectfully request reconsideration and favorable action in this case.

Rejections Under § 102

The Examiner rejects Claims 1-8, 10-16, 32-33, and 35-36 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,799,273 issued to Mitchell et al. ("*Mitchell*"). Applicants respectfully traverse the rejection of the claims and request reconsideration and favorable action.

Independent Claim 1 of the present application, as amended, recites the following:

A method for relating words in an audio file to words in a text file, comprising:
retrieving a text file comprising a plurality of textual words;
generating an audio file comprising a plurality of audible words based on the text file;
storing information relating each audible word to a corresponding textual word; and
transmitting the audio file to a telecommunication device operable to play the audio file to a user.

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987); MPEP § 2131. In addition, "[t]he identical invention must be shown in as complete detail as is contained in the . . . claims" and "[t]he elements must be arranged as required by the claim." *Richardson v. Suzuki Motor Co.*, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989); *In re Bond*, 15 U.S.P.Q.2d 1566 (Fed. Cir. 1990); MPEP § 2131 (*emphasis added*). *Mitchell* does not disclose, either expressly or inherently, each and every element of the claims.

For example, Applicants respectfully submit that *Mitchell* does not disclose, teach, or suggest "transmitting the audio file to a telecommunication device operable to play the audio

file to a user,” as recited in Claim 1. To the contrary, *Mitchell* is limited to a speech recognition engine (SRE) that is used in data processing. (Column 1, lines 8-10). Specifically, the SRE of *Mitchell* allows “audio data to be played back for any output data which has been dictated even if the data as a whole has been processed in such a way as to move, reorder, delete, insert or format the data.” (Column 1, lines 59-67). As illustrated in Figure 1, the SRE of *Mitchell* includes “an IBM (Trade Mark) compatible PC (personal computer) 1 having a keyboard 2 for inputting and correcting text and a pointing device 3 which in this embodiment is a mouse.” (Column 5, lines 1-4). The system also includes “a microphone 5, a loud-speaker 6, and an interface device 7.” (Column 5, lines 14-17). “During playback of the recorded audio signal, the audio signal is output from the computer 1 to the interface device 7 in digital form and is converted to an analog signal by a digital to analog converter within the interface device 7. “ (Column 5, lines 19-23). The analog signal is then output from the interface device 7 to play back the audio recording. (Column 5, lines 23-25). With regard to interface device 7, *Mitchell* provides that the interface device 7 “is provided with the IBM VoiceType system” but can include “any conventional hardware for recording and playing back sound in a personal computer.” There is no disclosure in *Mitchell*, however, of “transmitting the audio file to a telecommunication device operable to play the audio file to a user,” as recited in Claim 1. The recited features and operations are absent from the SRE of *Mitchell*.

For at least these reasons, Applicants respectfully request reconsideration and allowance of independent Claim 1, together with the claims that depend from Claim 1.

Independent Claims 7, 10, 15, 30, and 32 recite certain limitations that are analogous to the features discussed above with regard to Claim 1. Specifically, Claim 7 recites “transmitting the audio file to a telecommunication device operable to play the audio file to a user.” Claim 10 recites “transmitting the audible words to a telecommunication device associated with a user in real time as the audible words are generated.” Claim 15 recites “transmitting the audio word to a telecommunication device operable to play the audio word to a user.” Claim 30 recites “a TTS module operable to . . . transmit the audible words to a telecommunication device operable to play the audio file to a user.” Claim 32 recites logic operable to “transmit the audio file to a telecommunication device operable to play the audio file to a user.” Accordingly, for reasons similar to those discussed above with regard to Claim 1, Applicants respectfully submit that that

independent Claims 7, 10, 15, 30, and 32 are not anticipated by the *Mitchell* reference. For at least these reasons, Applicants respectfully request reconsideration and allowance of Claims 7, 10, 15, 30, and 32, together with the claims that depend from Claims 7, 10, 15, 30, and 32.

Regarding independent Claim 35, Applicants respectfully submit that *Mitchell* also does not disclose, teach, or suggest each every feature and operation recited in Claim 35. For example, Applicants respectfully submit that *Mitchell* does not disclose, teach, or suggest “for each audio file, storing information relating the audio file to the corresponding textual word, the information comprising an electronic marker within the audio file that indicates the position of the audible word within the text file,” as recited in independent Claim 35. Although *Mitchell* discloses that “each of the words recognized is identified by an identifier tag which identifies the position in the sequence of word[s],” the identifier tag of *Mitchell* is merely an entry within the “information files [that] are generated containing information” related to an audio data file. (Column 6, lines 50-55.) Specifically, *Mitchell* discloses that “two files are stored by the speech recognition engine application 11 which includes the information illustrated in tabular form in FIG. 3.” (Column 5, lines 48-51). The two files include the identifier tag and an audio start point and audio endpoint. (Figure 3). By disclosing that the identifier tag of *Mitchell* is included in the data file rather than the audio file, the identifier tag of *Mitchell* cannot be considered. not the equivalent of “an electronic marker within the audio file that indicates the position of the audible word within the text file,” as recited in independent Claim 35.

For at least these reasons, Applicants respectfully request reconsideration and allowance of Claim 35, together with Claim 36 that depends from Claim 35.

Rejections Under § 103

The Examiner rejects Claims 9, 17-31, 34, and 37 under 35 U.S.C. § 103(a) as being unpatentable over *Mitchell* in view of U.S. Patent No. 6,068,487 issued to Dionne (“*Dionne*”).

Claims 9 and 17 depend from independent Claims 7 and 15, respectively, and incorporate the limitations of their respective independent claims, which Applicants have shown above to be allowable. Additionally, Applicants submit that Claims 9 and 17 include further

features and operations that distinguish Claims 9 and 17 from the cited art. Because Claims 9 and 17 incorporate the limitations of their respective independent claims and are allowable at least because of their dependencies, Applicants have not provided detailed arguments with respect to Claims 9 and 17. However, Applicants remain ready to do so if it becomes appropriate. Applicants respectfully request reconsideration and allowance of Claims 9 and 17.

Independent Claim 18, as amended, recites “receiving from the user a voice command to spell an audible word in the audio file [and] in response to the voice command, identifying in a text file a textual word corresponding to the audible word.” Independent Claims 22, 26, and 37 recite certain analogous features and operations. Applicants respectfully submit that neither *Mitchell* nor *Dionne* (nor their proposed combination) disclose, teach, or suggest the recited features and operations. In the Office Action, the examiner relies upon *Dionne* for disclosure of “receiving from the user a . . . command to spell an audible word.” (Office action, page 5). *Dionne* merely relates, however, to a method “for having a reading machine spell a word [that] includes retrieving a word to be spelled, displaying the first character of the word on a display while applying a highlighting indicia to the character, synthesizing speech for the character to have the reading machine pronounce the displayed letter of the word, unhighlighting the displayed letter of the word, and retrieving a subsequent letter of the word.” (Abstract). Accordingly, the system of *Dionne* includes a monitor 20 and “a display system 38 which in a conventional manner processes [an] image file to permit it to be displayed 38 on the monitor 20.” (Column 2, lines 12-14 and 37-39).

Specifically, *Dionne* discloses that “[a] user can initiate reading of the scanned document at the beginning of the document . . . [or] by illustratively pointing 42 to the image representation of an item from the scanned document displayed on the monitor.” (Column 2, lines 59-64). Thus, the user of the *Dionne* system selects the word (or passage) to be read by using a mouse or other pointer to identify the word (or passage) on the monitor. *Dionne* also discloses:

After the nearest word or nearest document item has been determined 46 or 46', highlighting is applied 48 to an area associated with the item or word . . . The software will call 51 one of several possible routines to provide an enrichment feature for the reading system. These routines can

be accessed by a button or a feature on a pull-down menu of a window displayed on the reading machine display. For example, the user can request a definition of a word, and call a dictionary program to have the word read aloud. The user can have current word spelled, or have the reading system provide a synonym for the current word, or can look up a translation of the current word in a foreign dictionary, and so forth.

(Column 3, lines 8-21, [*sic*]). Accordingly, to the extent that a user command initiates the spelling of the word, the command is received using the pointer to identify a word on the display and a pull-down menu to select the routine for spelling the word. *Dionne* does not disclose, teach, or suggest "receiving from the user a voice command to spell an audible word in the audio file [and] in response to the voice command, identifying in a text file a textual word corresponding to the audible word," as recited in independent Claim 18 and analogously recited in independent Claims 22, 26, and 37.

For at least these reasons, Applicants respectfully request reconsideration and allowance of Claims 18, 22, 26, and 37, together with any claims that depend from Claims 18, 22, 26, and 37.

Furthermore, with regard to Claims 9, 17-31, 34, and 37, Applicants respectfully submit that the proposed *Mitchell-Dionne* combination is improper. The M.P.E.P. sets forth the strict legal standard for establishing a *prima facie* case of obviousness based on modification or combination of prior art references. "To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references where combined) must teach or suggest all the claim limitations." M.P.E.P. § 2142, 2143. The teaching, suggestion or motivation for the modification or combination and the reasonable expectation of success must both be found in the prior art and cannot be based on an Applicant's disclosure. *See Id.* (citations omitted). "Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art" at the time of the invention. M.P.E.P. § 2143.01. Even the fact that references *can* be modified or

combined does not render the resultant modification or combination obvious unless the prior art teaches or suggests the desirability of the modification or combination. *See Id.* (citations omitted).

The governing Federal Circuit case law makes this strict legal standard even more clear.¹ According to the Federal Circuit, “a showing of a suggestion, teaching, or motivation to combine or modify prior art references is an essential component of an obviousness holding.” *In re Sang-Su Lee*, 277 F.3d 1338, 1343, 61 U.S.P.Q.2d 1430, 1433 (Fed. Cir. 2002) (quoting *Brown & Williamson Tobacco Corp. v. Philip Morris Inc.*, 229 F.3d 1120, 1124-25, 56 U.S.P.Q.2d 1456, 1459 (Fed. Cir. 2000)). “Evidence of a suggestion, teaching, or motivation . . . may flow from the prior art references themselves, the knowledge of one of ordinary skill in the art, or, in some cases, the nature of the problem to be solved.” *In re Dembiczak*, 175 F.3d 994, 999, 50 U.S.P.Q.2d 1614, 1617 (Fed. Cir. 1999). However, the “range of sources available . . . does not diminish the requirement for actual evidence.” *Id.* Even a determination that it would have been obvious to one of ordinary skill in the art at the time of the invention to try the proposed modification or combination is not sufficient to establish a *prima facie* case of obviousness. *See In re Fine*, 837 F.2d 1071, 1075, 5 U.S.P.Q.2d 1596, 1599 (Fed. Cir. 1988).

In addition, the M.P.E.P. and the Federal Circuit repeatedly warn against using an applicant's disclosure as a blueprint to reconstruct the claimed invention. For example, the M.P.E.P. states, “The tendency to resort to ‘hindsight’ based upon applicant's disclosure is often difficult to avoid due to the very nature of the examination process. However, impermissible hindsight must be avoided and the legal conclusion must be reached on the basis of the facts gleaned from the prior art.” M.P.E.P. § 2142. The governing Federal Circuit cases are equally clear. “A critical step in analyzing the patentability of claims pursuant to [35 U.S.C. § 103] is casting the mind back to the time of invention, to consider the thinking of one of ordinary skill in the art, guided only by the prior art references and the then-accepted wisdom in the field. . . . Close adherence to this methodology is especially important in cases where the very ease with which the invention can be understood may prompt one ‘to fall victim to the insidious effect of a hindsight syndrome wherein that which only the invention taught is used against its teacher.’”

¹ Note M.P.E.P. 2145 X.C. (“The Federal Circuit has produced a number of decisions overturning obviousness rejections due to a lack of suggestion in the prior art of the desirability of combining references.”).

In re Kotzab, 217 F.3d 1365, 1369, 55 U.S.P.Q.2d 1313, 1316 (Fed. Cir. 2000) (citations omitted). In *In re Kotzab*, the Federal Circuit noted that to prevent the use of hindsight based on the invention to defeat patentability of the invention, the court requires the Examiner to show a motivation to combine the references that create the case of obviousness. *See id.* *See also, e.g., Grain Processing Corp. v. American Maize-Products*, 840 F.2d 902, 907, 5 U.S.P.Q.2d 1788, 1792 (Fed. Cir. 1988). Similarly, in *In re Dembiczak*, the Federal Circuit reversed a finding of obviousness by the Board, explaining that the required evidence of such a teaching, suggestion, or motivation is essential to avoid impermissible hindsight reconstruction of an applicant's invention:

Our case law makes clear that the best defense against the subtle but powerful attraction of hind-sight obviousness analysis is *rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references*. Combining prior art references without evidence of such a suggestion, teaching, or motivation simply takes the inventor's disclosure as a blueprint for piecing together the prior art to defeat patentability—the essence of hindsight.

175 F.3d at 999, 50 U.S.P.Q.2d at 1617 (emphasis added) (citations omitted).

In the Final Office Action, the Examiner acknowledges that *Mitchell* does not disclose “that the system identifies an audible word to be spelled in response to the command to spell.” (Office Action, page 5). The Examiner speculates, however, that “it would have been obvious” to “modify the system of *Mitchell* to provide the spelling of words in the text, to aid in the editing of recognized text and in the correcting of recognition errors.” (Office Action, page 5). Applicants respectfully submit that the Examiner's summary conclusion amounts to mere speculation and does not provide the suggestion or motivation necessary to make the proposed combination.² The mere possibility that the spelling function of *Dionne* might improve the SRE of *Mitchell*, as the Examiner asserts, does not even remotely provide the required teaching, suggestion, or motivation to modify the teachings of *Mitchell*. Applicants respectfully submit

² If the Examiner is relying on “common knowledge” or “well known” art in support of his rationale for combining *Mitchell* and *Dionne*, the Examiner is requested to produce a reference in support of his position pursuant to M.P.E.P. § 2144.03. If the Examiner is relying on personal knowledge to supply the required motivation or suggestion to combine *Mitchell* and *Dionne*, Applicants respectfully request that the Examiner produce an affidavit supporting such facts pursuant to M.P.E.P. § 2144.03.

that in making this unobvious leap the Examiner has used the type of hindsight reconstruction explicitly forbidden by the M.P.E.P. and Federal Circuit.

Furthermore, It is essential to view the invention as a whole, taking each element into account as well as the advantages, properties, utilities, and results of the invention. *In re Chupp*, 816 F.2d 643, 2 U.S.P.Q.2d 1437 (Fed. Cir. 1987). As discussed above, it is the Examiner's position that "it would have been obvious" to "modify the system of *Mitchell* to provide the spelling of words in the text, to aid in the editing of recognized text and in the correcting of recognition errors." (Office Action, page 5). Applicants respectfully submit, however, that the provided motivations do not provide a suggestion to combine these two references.

The very principle and purpose of the SRE disclosed in *Mitchell* is to allow "audio data to be played back for any output data which has been dictated even if the data as a whole has been processed in such a way as to move, reorder, delete, insert or format the data." (Column 1, lines 59-67). Thus, *Mitchell* is merely a modification of existing dictating software such as DragonDictate and merely replays dictated text to help a user performing proofreading functions. This objective is very different from the objective of *Dionne*, which is to provide a speller feature that "assists people with dyslexia by reinforcing the appearance of the letters one at a time in the string as the letters are being pronounced by the speller 60." (Column 4, lines 10-13). Furthermore, since the SRE of *Mitchell* displays the dictated and revised text to a user on a monitor as it is being played back to the user, the spelling of the word is provided to the user on the monitor. Neither reference provides any suggestion as to how providing spelling of a word to a user of the SRE of *Mitchell* would be advantageous in performing proofreading functions. Accordingly, Applicants respectfully submit that one of ordinary skill in the art at the time of Applicants' invention would not have been motivated to make the proposed *Mitchell-Dionne* combination.

For at least these reasons, Applicants respectfully submit that the proposed *Mitchell-Dionne* combination is improper.

CONCLUSION

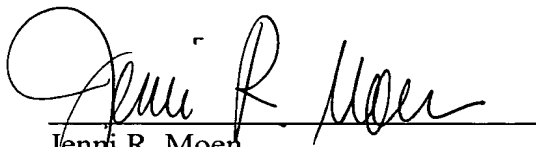
Applicants have made an earnest attempt to place this application in condition for allowance. For the foregoing reasons, and for other reasons clearly apparent, Applicants respectfully request reconsideration and full allowance of all pending claims.

If the Examiner feels that a telephone conference would advance prosecution of this application in any manner, the Examiner is invited to contact Jenni R. Moen, Attorneys for Applicants, at the Examiner's convenience at (214) 953-6809.

Applicants believe that no fees are due, however, the Commissioner is hereby authorized to charge any fees or credit any overpayment to Deposit Account No. 02-0384 of Baker Botts, L.L.P.

Respectfully submitted,

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